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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/060,996
Filing Date: January 30, 2002
Appellant(s): AUPPERLE ET AL.

Scott D. Paul
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/8/2007 appealing from the Office
action mailed 8/7/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct except for the reference number "240" which should be corrected to -204-.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

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(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,338,050

CONKLIN et al.

1-2002

Horn et al. (US PG-Publication 2002/0156688) published on 10/24/2002

Lee (US PG-Publication 2005/0187866 A1) published on 8/25/2005.

(9) Grounds of Rejection

The following ground(s) of rejection (reproduced from the third office action mailed on 8/7/2006) are applicable to the appealed claims:

Quote: "

Claim Rejections - 35 USC § 103

4.1. Claims 4, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin in view of Horn in view of Lee (US Publication 2005/0187866).

Regarding claim 4, Conklin discloses that "Prior Art" existed at the time of the applicant's invention teaching a method of cooperatively processing e-business transactions in an e-business complex comprising the steps of: registering a plurality of virtual store operators with the e-business complex, each said registration

establishing a virtual store in the e-business complex; providing to individual ones of on-line shoppers in the e-business complex, window displays of products offered for sale by virtual stores in the e-business complex, and accepting shopper orders for said products from said individual on-line shoppers; (see at least Fig.2 (b), col.2, line 62-col.3, line 13 which disclose a virtual mall "24" website including a plurality of virtual store operators "28" registered to sell products to on-line shoppers in an e-business complex by displaying the products offered on the on-line shoppers computer monitors "08 a, 08 b..." via world wide web which uses Microsoft Windows software. The individual on-line shoppers using their computer terminals and Microsoft windows can display the products being sold by virtual stores, browse the products, select them via a shopping cart. The payment is collected by credit cards for the stores after accepting orders from the on-line shoppers. See also col.10, lines 1-67, col.11, line 60-col.12, line 1 which teaches that an administrator coordinates the placement of orders and collection of payment. Conklin's invention discloses improvements over this cited prior art by additionally providing a multivariate negotiations engine allowing the buyers and store to negotiate prices, provide handling of payments, international transactions and establishing community Websites, which resemble a Virtual Mall website, as cited above including/integrate a number of seller websites via the community website (see at least col.14, line 1-col.15, line 8 and col.18, line 38-col.19, line 27). Conklin further teaches

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notifying selected store operators of said shopper orders, said selected store operators operating virtual stores in the e-business complex which correspond to said products ordered by said on-line shoppers (see at least col.19, lines 28-37 and col.25, lines 52-66 which teach notifying the seller, that is the store operator as claimed in the application, of the purchaser's interest in ordering an item);

Conklin does not teach notifying selected vendors of said shopper orders, said selected vendors supplying said products offered for sale by said selected store operators; fulfilling said shopper orders with said products supplied by said selected vendors; and collecting payments for said shopper orders from said on-line shoppers and distributing portions of said payments to each of said vendors and said store operators. Note: The concept of the applicant's invention, as best understood by the examiner, is that the store operators representing virtual store websites hosted on the virtual Mall web site are acting as selling agents to vendors/manufacturers who are the actual shippers of goods and therefore portions of payments collected from the on-line shoppers are distributed to both the virtual store operator and the vendor who ships the goods. In the same field of endeavor, that is conducting global commerce via referral Websites Horn teaches notifying selected vendors of said shopper orders, said selected vendors supplying said products offered for sale by said selected store operators; fulfilling said shopper orders with said products supplied by said selected vendors; and collecting payments for said shopper orders from said on-line shoppers and distributing portions of said payments to each of said vendors and said store operators (see at least paragraphs 0321 and 0686 which disclose that from the payments received the purchase of the items portions of said payments are distributed to the Referral Websites, which correspond to the virtual stores in the claimed application, and to the manufacturer, which correspond to the vendors, as claimed in the application, and page 39, claim 1, lines 24-36, *"collecting payment for said at least one product from said Buyer at a Website which is e-commerce enabled for processing purchase transactions, and notifying the manufacturer of said at least one product that a purchase has been made and a at least one product needs to be shipped to said Buyer, the shipment to be made by a shipper for tangible products and by making the products downloadable by the Buyer for downloadable digital products, said digital products being in the group of digital products comprising text files, video files, and audio files. whereby, manufacturers around the world may deliver products "*).

In view of explicit teachings of Horn, it would be obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Conklin to incorporate the teaching of notifying selected vendors of said shopper orders, said selected vendors supplying said products offered for sale by said selected store operators; fulfilling said shopper orders with said products supplied by said selected vendors; and collecting payments for said shopper orders from said on-line shoppers and distributing portions of said payments to each of said vendors and said store operators because it would enable manufacturers/vendors to increase revenues and profits by being presented more opportunities to sell their products via Referrals from the Referral Web sites all over the world, wherein as mentioned above, referral web sites correspond to the store operators as participants in a virtual Mall or a Global store in Horn.

Conklin teaches that the participants in a community, comprises a host community Web site, that is a Virtual Mall web site including a plurality of seller web sites, that is virtual store operators selling products to customers and these store operators act as referral web sites or agents selling products of vendors/ manufacturers, as analyzed above and earning fees or commissions from the purchase revenues. Conklin also teaches that the participants in a community that is sellers could also be buyers (see at least col.17, lines 19-21, *"...In some cases both.."*, that is a seller or a referral website can be both a seller and buyer) and therefore one of the store operator could participate as a buyer buying products/services ending into a transaction like any other product as shown in Conklin (see at least col.10, lines 1-7).

Conklin in view of Horn as applied to claim 4 does not teach providing to said store operators a catalog of services offered for sale by associated services providers and, brokering at least one transaction for at least one of said services between at least one of said store operators and at least one of said service providers. Lee, in the field of same endeavor discloses a web-based system and method for issuers [corporations, government agencies, etc], financial intermediaries [banks, savings and loan institutions, etc.], and end investors [holders of securities] for selling financial products/securities (see at least paragraphs 0002-0004). Lee also discloses using this web based

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system and method to provide to said store operators [corresponds to issuers and intermediaries in Lee] a catalog of services offered for sale by associated services providers and, brokering at least one transaction for at least one of said services between at least one of said store operators and at least one of said service providers (see at least paragraph 0004, lines 9-13. Presenting or offering of services of lawyers, accountants, auditors, and of other professionals to the issuers and financial intermediaries corresponds to providing a catalog of services offered for sale by associated services providers [corresponds to lawyers, accountants, auditors, and of other professionals] and, brokering at least one transaction for at least one of said services between at least one of said store operators and at least one of said service providers. See also Abstract, paragraphs 0008,0012-0014,0055,0075-0076, 0086,0187, 0246). In view of Lee, it would be obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Conklin in view of Horn to incorporate the feature of brokering professional services, such as legal, auditing, translation and tax and accounting services to the store operators of the virtual mall because, as disclosed in Lee, it will advantageously and efficiently facilitate Conklin's system and method in implementing of transactions both domestic and international which require legal and tax counsel/guidance in following the international procedures/rules/regulations and also in translating documents from one language to another language.

Regarding claim 7, Lee teaches brokering tax and accounting services between a tax and accounting business partner and individual ones of said store operators and forwarding tax documents and accounting statements produced by said business partner to said individual ones of said store operators (see at least paragraph 0004, lines 9-13. Presenting or offering of services of lawyers, accountants, auditors, and of other professionals to the issuers and financial intermediaries includes or suggests brokering tax and accounting services between a tax and accounting business partner [corresponds to the intermediaries and professionals related to legal/auditing/ accounting services] and individual ones of said store operators [corresponds to the issuers and financial intermediaries in Lee] and forwarding tax documents and accounting statements produced by said business partner to said individual ones of said store operators [it would be obvious to one of an ordinary skilled in the art that while providing legal/accounting/auditing services to the issuers the service providers, that is lawyers/accountants/auditors would exchange related documents including tax documents with the store providers. In view of Lee, it would be obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Conklin/Horn/Lee as applied to claim 4 to incorporate the feature of brokering tax and accounting services between a tax and accounting business partner and individual ones of said store operators and forwarding tax documents and accounting statements produced by said business partner to said individual ones of said store operators because, as disclosed in Lee, it will advantageously and efficiently facilitate Conklin's system and method in implementing of transactions both domestic and international which require legal and tax counsel/guidance in following the international procedures/rules/regulations and also in translating documents from one language to another language.

Regarding claims 8 and 11, their limitations are closely parallel to the limitations of claims 4 and 7 and are therefore analyzed and rejected on the same basis as being unpatentable over Conklin in view of Horn and further in view of Lee.

(10) Response to Argument

The applicant's arguments are directed to rejection of claim 4 and accordingly the examiner has limited his response to those arguments only.

The applicant argues (See Appeal brief, pg.5, line 8-pg.6, line 8 and pg.7, line 10-pg.8, line 8) (a) that one of an ordinary skilled in the art would not be motivated to modify the combination of prior art of Conklin and Horn in view of Lee so as to arrive at the claimed invention because the prior art of Conklin and Horn are related to e-commerce on the internet such as that of E-bay's non-auction store operators and that of Lee's prior art is directed to a " web based method and system that facilitates business transactions including the raising of capital in global financial markets via the internet" and (b) that the motivation for proposed combination that, " it will advantageously and efficiently facilitate Conklin's system and method in implementing of transactions both domestic and international which require legal and tax counsel/guidance in following the international procedures/rules/ regulations and also in translating documents from one language to another language ", used by the examiner is not factually supported. The examiner respectfully disagrees for the following reasons:

(i) All three inventions of Conklin, Horn and Lee are directed to e-commerce including conducting business transactions on Internet and therefore they are in the same field of endeavor. Conklin teaches conducting web-based business transactions including purchasing and selling of products and services either globally or locally (see at least Abstract, col.19, lines 14-65 ["a seller Website within the community on which to

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include the seller's marketing and product information, along with pricing, terms, service offerings and so on..... Buyer processes shown in FIG. 1g include search and evaluate processes 70, which enable a prospective buyer to find companies and their products in the community and investigate their prices, terms and service offerings.....], Figs.10-2, 10-3 [discloses listing of products and services that a company would sell and display], and Figs 11a-1, 2,3, Fig.11b, 12-16 [teach web-based implementing global business transactions including payments through letters of credit]). Horn teaches conducting web-based business transactions involving purchasing and selling of products and services globally (see at least paragraph 0003, [*"The field of this invention is global sale of products and services using electronic means of (a) communications, (b) data storage and retrieval, (c) taking of orders, (d) fulfillment, (e) transfers of payments, and (f) providing customer service after the sale. Both business-to-business and business-to-consumer sales are effectuated"*], using other/ancillary websites for providing services, such as payment processing, currency conversion quotations and tax computing services (see at least paragraphs 0164 [*"Ancillary Resource Websites are Websites accessible via the Internet suite of protocols that provide specific informational or processing services, generally on a subscription basis. Examples include (a) credit card and general payment processing, (b) currency conversion quotations, and (c) tax computing services.*] and 0313) and includes a list of links of ancillary services required/related to the purchase of a product (see paragraph 0674). Lee teaches conducting web-based business transactions including financial transactions involving buying and selling of securities and provision of professional services from law firms, accounting firms and translational agencies to the users (see at least Abstract and paragraphs 0008-0009 and 0013). Therefore, from the above evidences, it would be obvious to one of an ordinary skilled in the art that all the three

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prior arts of Conklin, Horn and Lee are directed to the common filed of endeavor that is of conducting web-based e-commerce of buying and selling products and services on Internet. Further, as disclosed in Horn and Lee, the prior art suggests providing ancillary services to the users, such as tax, payment processing, legal and translational services. It would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention that business transactions of Conklin are conducted globally and the users of Conklin system can require additional services such as translation of documents from one international language to another [example translating Chinese/French documents to English as suggested in Lee], tax assistance in dealing with the other country laws, as indicated in Horn and therefore, it would be obvious to one of an ordinary skilled in the art to modify Conklin to incorporate the teachings of Lee of providing legal/accounting/translational services to the users conducting global business transactions because that would make it convenient for them to deal and negotiate with buyers and sellers of other countries having different laws and languages.

The following court cases justify examiner's reasons for motivation to modify Conklin/Horn with Lee's teachings:

In re Fine, 5 USPQ2d 1596 (CA FC 1988)

The PTO can satisfy the burden under section 103 to establish a prima facie case of obviousness "by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

In the instant case, the examiner has established a prima facie case by showing an objective teaching in the prior arts of Horn and Lee that is of a need and providing associated services, such as legal, accounting, tax and translational related

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services to the users engaged in business transactions of buying and selling products and services. These objective teachings would be available to one of an ordinary skill in the art at the time of the applicant's invention and would lead that individual to combine these relevant teachings of Lee, Horn and Conklin.

In re Bozek, 163 USPQ 545 (CCPA 1969)

"Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'"

In the instant case, the examiner has established that the knowledge of a need and providing associated services, such as legal, accounting, tax and translational related services to the users engaged in business transactions of buying and selling products and services was available in the prior arts of Horn and Lee and therefore the examiner could properly rely on a conclusive of obviousness from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.

Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193 (CA FC 1983)

"Fact that two disclosed apparatuses would not be combined by businessmen for economic reasons is not same as saying that it could not be done because skilled persons in art felt that there was some technological incompatibility that prevented their combination; only latter fact is telling on nonobviousness issue. "

In the instant case, because the applicant opines that the arts of Conklin/Horn cannot be combined for economic reasons, that is the prior art of Conklin and Horn are related to e-commerce on the internet such as that of E-bay's non-auction store

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operators and that of Lee's prior art is directed to a " web based method and system that facilitates business transactions including the raising of capital in global financial markets via the internet **is not same** as saying that it could not be done because skilled persons in art felt that there was some technological incompatibility that prevented their combination; only latter fact is telling on nonobviousness issue.

The applicant further argues (see Appeal brief page 6, line 15- page 7, line 4) that Lee does not disclose a " catalog of professional services offered for sale". The examiner respectfully disagrees. The examiner has interpreted the claimed phrase, " a catalog of professional services" as a record of professional services available for selection and Lee does suggest this (see paragraphs 0075 and 0076 and Fig.6) by stating that the user is allowed to select a legal counsel or other external professionals from a list of attorneys wherein the list of attorneys or a group of law firms describing the kind of legal work they do represent a catalog or a record or a list of available/offered professional services from which the user can select. The claim language does not limit on the methods or ways as how to select a professional service from the available catalog/record/list of attorneys providing professional services and therefore the applicant's arguments, " For example, the Examiner referred to paragraph [0075] of Lee, which teaches two different ways a user may seek and engage professional services. One option is...and another option is.....", are not relevant. Such services, when selected are paid for by the user.

(11) Related Proceeding(s) Appendix

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No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained

Respectfully submitted,



Yogesh C. Garg

Primary Examiner AU 3625

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Jeffrey Smith

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SPE (Appeal Specialist-Tech Center 3600)